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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,830	07/15/2003	Kenneth McClintock	24168067.17	7187

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BAKER & MCKENZIE
PATENT DEPARTMENT
2001 ROSS AVENUE
SUITE 2300
DALLAS, TX 75201

EXAMINER	
LE, KHANH H	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,830	MCCLINTOCK, KENNETH	
	Examiner	Art Unit	
	Khanh H. Le	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2003 and October 7, 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *08/21/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

1. This Office Action is responsive to the original Application and the preliminary amendment dated October 7, 2003. The amended specifications and claims and new claims have been entered as requested. Claims 1-16 are now pending. Claims 1, and 2 are independent.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 7 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

As to claims 7 and 14, "wherein the user is unaware of the determining" , a negative limitation, is not supported in the specifications, thus it is not clear what the bounds of this limitation are. See MPEP 2173.05(i). Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7 and 14 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

6. In claims 7 and 14, "wherein the user is unaware of the determining" is rejected because the user's mental state does not clearly indicate what action is or is not being done. People can be unaware of what is happening even when they are watching it happen, so how the mental state of the user further defines the actions performed is unclear. Appropriate correction is required.

Claim Rejections - 35 USC 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyssen (2001/0053981).

As to claims 1 and 2,

(Claim 1 reads:

A method of promoting a web site using a product label

the method comprising:

placing a unique Internet address associated with an Internet site and available to the public on
an advertisement displayed on a label;
placing a unique identifier on the advertisement;
shaping the label for distribution on the top of a can,
presenting an Internet site to a user that navigates to the Internet address;
prompting the user to enter the unique identifier on the Internet site; and
determining by the entry of the unique identifier the label as the source of the Internet address to the user.)

Wyssen discloses a label (10) to be placed on an article (20) (which would inherently include the top of a can) comprising an advertisement (14) for an entity; a unique internet address (inherently all Internet addresses are unique) (www.IDFix.com) associated with the entity, a unique identifier (12) associated with the advertisement. A consumer visits a web site or Internet page
associated with the Internet address to enter the unique identifier (see page 2, see col. 2, lines 45-58 through page 3, col. 1 , Lines 1-5) to uniquely identify the label and the article.

Thus WYSSEN discloses all the steps of claim 1 above except the article is not a label on top of a can and the label is not shaped to the can.

As to shaping the label for distribution on the top of a can, WYSSEN discloses the label placed on an article surface, thus the WYSSEN's label is capable of being placed on the top of a can. It would have been obvious to one skilled in the art at the time the invention was made to shape the WYSSEN's label to fit the top of a can if that is the intended use of it. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey 370 F.2d 576,

152 USPQ 235 (CCPA 1967) and In re Off 312 F.2d 937, 939, 136 USPQ 458,459 (CCPA 1963).

As to "determining by the entry of the unique identifier the label as the source of the Internet address to the user" , in Wyssen, the Internet address being specifically configured for user input of the unique identifier, sets forth the intended use of the Internet address which is to uniquely identify the label and/or the article.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior ad in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. (In Wyssen, entry of the article identifier while the user is at the internet site, during the same transaction, logically associates the article identifier and thus the label/article with the internet site as seen from the label by the user and thus meets the claimed invention.) In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and In re Off, 312 F.2d 937, 939, 136 USPQ 458,459 (CCPA 1963).

Please note that all limitations of claim 2 are contained within claim 1 by virtue of the use of "comprising" in claim 2 which allows the step of adding another unique identifier as in claim 1.

As to claims 3-5, 10-12 (dependent on claims 1 or 4, 2 or 11) WYSSEN does not specifically disclose
placing the Internet address
and unique identifier on an unexposed face of the label when the label is positioned on the top of the can; or placing the unique identifier
a face of the label opposite the internet address; or

placing the unique identifier on an unexposed face of the label when the label is positioned on the top of the can.

However it would have been obvious to one skilled in the art at the time the invention was made to place the internet address and unique ID wherever desired on the Wyssen's label since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

As to claims 6 and 13, WYSSEN discloses uniquely determining the label/article to someone other than the user (see at least abstract, to the owner, system operator).

As to the label being the source of the Internet address , see the pertinent discussion above.

As to claims 7 and 14(dependent on claim 6) it can be said that the user in Wyssen is unaware of the particular moment when the determination (by the computers) of the identity of the article is done thus "the user is unaware of the determining' as claimed.

As to claims 8 and 15(dependent on claims 1 and 2) WYSSEN discloses rewards for finders (see page 8) which is interpreted as promotional contests to potential finders to be the first ones to find and collect the rewards.

As to claims 9 and 16 (dependent on claims 1 and 2), WYSSEN discloses wherein determining further comprises identifying
a geographic location of the label (see at least page 8, paragraph [0163]: email address and geographical address of owner are associated with the label).

Conclusion

9. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cairns, US6173267, discloses a card (Fig. 1, item 10) to be placed with an article (Fig. 1, items 10, 20) comprising an advertisement (see at least col. 3 lines 53-63) for an entity; a unique lnternet address (Fig. 2, item 14 and associated text) associated with the entity, a unique identifier ((Fig. 2, item 16 and associated text) associated with the advertisement. A consumer visits a web site or Internet page associated with the Internet address to enter the unique identifier (see at least Figs. 1 and associated text), and the card is uniquely identified and the winning status is determined.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov. (However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. (After our Art Unit moves to the Alexandria campus, sometime during or after April 2005, the Examiner's phone number will be 571-272-6721 and Mr. Eric Stamber's will be 571-272-6724. The current numbers are still in service until the move). The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

March 11, 2005

KHL

KHL

JAMES W. MYHRE
PRIMARY EXAMINER